

III. REMARKS

Claims 1-19 are pending in this application. By this amendment, claims 1, 9 and 17-19 have been amended. Applicant does not acquiesce in the correctness of the rejections and reserves the right to present specific arguments regarding any rejected claims not specifically addressed. Further, Applicant reserves the right to pursue the full scope of the subject matter of the original claims in a subsequent patent application that claims priority to the instant application. Reconsideration in view of the following remarks is respectfully requested.

In the Office Action, claims 1-19 are rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. Claims 1-19 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite. Claims 1, 3-9, and 11-18 are rejected under 35 U.S.C. §102(b) as allegedly being anticipated by Stupek et al. (U.S. Patent No. 5,960,189), hereafter “Stupek,” in view of Taylor (U.S. Patent No. 5,721,824), hereafter “Taylor.” Claims 2 and 10 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Stupek and Taylor and further in view of “Y2K Compliance and the Distributed Enterprise” by Gowen et al., hereafter “Gowen.” Claims 6 and 14 are rejected under 35 U.S.C. §103(a) as being unpatentable over Stupek and Taylor and further in view of “IMS/ESA Sysplex Data Sharing: An Implementation Case Study” by Boyle *et al.*, hereafter “Boyle.”

Initially, Applicant thanks the Examiner for the telephone interview of December 16, 2005 with their representative, Hunter E. Webb. No proposed amendment was submitted in advance of the interview. In the interview, Applicant’s representative discussed with the Examiner features of the claimed invention not believed to be taught by the references, such as those specified below. In addition, Applicant’s representative explained, based on the entirety of

the specification itself, the support for the use of the term “all known second maintenance items.”

No agreement was reached.

A. REJECTION OF CLAIMS 1-19 UNDER 35 U.S.C. §112

The Office has asserted that claims 1-19 do not satisfy the written description requirement and are indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Specifically, the Office objects to the use of the limitation “all known second maintenance items.” Applicant has amended claims 1, 9, and 17-19 to recite “~~known~~ second maintenance items that are known to the to the database as being able to be installed on the computer system.” Applicant submits that this limitation is explicitly supported, *inter alia*, by Applicant’s original specification (page 8, lines 13-22) and implicitly by the searching of the database for prerequisite items and corequisite items corresponding to each maintenance item of the list entered in step 20. Page 9, lines 6-9. Specifically, the fact that the database is searched to obtain information about the maintenance items being installed on the computer system indicates that the database is a master database of data items known to be installable on the computer system.

As further indication of the global nature of the database, Applicant points out the difference in the specification between the definition of second maintenance items and that of third maintenance items. Specifically, the specification teaches that the list of third maintenance items “...may be a list of maintenance items needed to be put on to the computer system.” Page 9, lines 1-2. In contrast, the definition of second maintenance items in the specification recites

“[t]he database application has a database of second maintenance items known as PTF [Program Temporary Fixes].” Page 8, lines 14-15.

To this extent, the definition of second maintenance items of the claimed invention does not have the limitation of that of the third maintenance items, that is that they may be part of an upgrade package. Under common rules of construction, since the limitation that is explicitly included in the definition of third maintenance items is not included in the definition of second maintenance items, the definition of second data items specifically excludes the limitation that it includes only those that are part of a particular upgrade package. Thus, Applicant is justified in indicating the global nature of the database in the claims to distinguish the second maintenance items from the third maintenance items that may be needed to be put on to the computer system. Accordingly, Applicant requests that the rejection be withdrawn.

B. REJECTION OF CLAIMS 1-19 UNDER 35 U.S.C. §103(a)

With regard to the 35 U.S.C. §103(a) rejection over Stupek in view of Taylor, Applicant asserts that the combined features of the cited references do not teach each and every feature of the claimed invention. For example, with respect to independent claims 1, 9 and 17-19, Applicant respectfully submits that Stupek fails to disclose, *inter alia*, starting in said second host session, a database application having a database of all second maintenance items that are known to the to the database as being able to be installed on the computer system. The Office equates this feature in the claimed invention with the upgrade database of Stupek that “...contains information regarding the dependencies between the package and other upgrade objects or packages.” Col. 7, lines 8-10. To this extent, as stated above, database of the second

maintenance items of the claimed invention is not limited to data regarding each upgrade package as are the database items of Stupek, but instead is a master database of all maintenance known to the system. As such, Stupek does not teach that the database has such a global nature.

The claimed invention, in contrast, includes "...a database application having a database of all second maintenance items that are known to the to the database as being able to be installed on the computer system, and prerequisite items and corequisite items corresponding to each of said known second maintenance items." Claim 1. As such, the known second maintenance items in the database as included in the claimed invention are not limited, as in Stupek, to data respecting a particular upgrade package, but instead the database includes all second maintenance items that are known to the database as being able to by installed on the computer system, whether the known second maintenance items are included in a particular upgrade package or not. For the above reasons, the upgrade database in Stupek is not taught or suggested by the database that includes known second maintenance items as included in the claimed invention. Taylor does not cure this deficiency. Accordingly, Applicant requests that the rejection be withdrawn.

With further respect to independent claims 1, 9, 17 and 18, Applicant asserts that Stupek does not teach, *inter alia*, searching said database of known second maintenance items for records matching each of said new third maintenance items to find records that have said prerequisite items and corequisite items. The Office equates the first list of new third maintenance items of the claimed invention with the "upgrades to the network resources [that] are provided to a service by a distribution medium (not shown), such as a CD-ROM" of Stupek. Office Action, page 6. The Office then attempts to equate the database of known second

maintenance items of the claimed invention with the upgrade database. Office Action, page 7. However, the upgrade database of Stupek is specified as being contained on the CD-ROM. Col. 3, lines 44-50. As such, the upgrade database is included in the upgrades to the network resources that are provided by the distribution medium of Stupek and are not a separate component. Col. 3, lines 31-33, lines 44-45, lines 50-52. Under this scenario, a search of the database of known second maintenance items for records matching each of said new third maintenance items as included in the claimed invention would have the upgrade database of Stupek being searched by the upgrades, which also include the upgrade database.

Furthermore, Stupek never teaches that the “upgrades” are searched specifically to find records that have prerequisite items and/or corequisite items. Specifically, Stupek does not explicitly teach that the upgrade database is searched using a separate list of new upgrades for items having dependency information. Instead, the retrieval of information taught in Stupek is limited to the following two comparisons: “...a) whether or not a particular upgrade package corresponds to a resource on the server, and b) whether or not the version number of the upgrade package matches the version number of the corresponding network resource.” Col. 4, lines 20-27. Stupek only reports or displays records that meet those comparisons, whether or not dependencies are present, and as such does not specifically search to find records that have dependency information. Col. 4, lines 20-25. As such, even though dependency information may be included in the records that are found during the search for the above two comparisons and this dependency information may be used to perform automatic upgrades, Stupek never teaches that the upgrade database is specifically searched for records that have the dependency information. In summary, Applicant submits that Stupek does not search for dependencies, but

only for the factors that indicate the occurrence of a package upgrade independent of the presence or absence of dependencies and displays upgrade information whether or not these dependencies exist. Accordingly, Applicant respectfully requests that the rejection be withdrawn.

With still further respect to claims 1, 9, 17 and 18, Applicant respectfully submits that the cited references do not include entering a first list of new third maintenance items in said maintenance application and adding said corresponding prerequisite items and corequisite items to said first list. The Office admits that Stupek does not expressly disclose this feature. Office Action, page 10. Instead, the Office attempts to rely on Taylor, which teaches “[i]f the dominant package has a dependent package not already installed, the method constructs a trailer script process and an action list. The action list has action entries identifying dependent packages not previously installed.” To this extent, Taylor teaches creating an action list that identifies only dependent packages. Taylor, however, does not teach or suggest that dependent packages are added to the original list of items from which the dependent package was derived. In contrast, the claimed invention includes adding to the “...first list of new third maintenance items...” “...said corresponding prerequisite items and corequisite items.” Claim 1. As such, unlike Taylor, this step expressly adds prerequisite items and corequisite items that have been found in the database search to the original list of new third maintenance items (i.e., the items in the original upgrade package to be installed on the system). Neither Stupek nor Taylor teach this feature. Accordingly, Applicant requests that the rejection be withdrawn.

With final respect to claims 1, 9, 17 and 18, Applicant respectfully submits that the cited references do not include thereafter ordering, receiving, and applying said items on said order list after the other steps have been completed. Instead, the retrieval of appropriate upgrade packages

from the distribution medium and supplying of the packages to the server upgrader of Stupek occurs at the outset. Nowhere does Stupek teach or suggest that this step occurs subsequent to the other steps. In contrast, the claimed invention includes "...thereafter ordering, receiving, and applying said items on said order list." Claim 1. As such, the ordering, receiving, and applying of the items on the order list of the claimed invention does not occur at the outset as in Stupek, but rather thereafter. Taylor does not cure this deficiency. Accordingly, Applicant respectfully requests that the Office withdraw its rejection.

With respect to new claim 20, Applicant respectfully submits that the cited references do not teach or suggest each and every feature of the claimed invention. Accordingly, Applicant respectfully submits that the claim is in condition for allowance.

With respect to dependent claims, Applicant herein incorporates the arguments presented above with respect to independent claims 1, 9, 17 and 18 from which the claims depend. Furthermore, Applicant submits that all dependant claims are allowable based on their own distinct features. Since the cited art does not teach each and every feature of the claimed invention, Applicant respectfully requests withdrawal of this rejection.

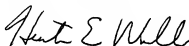
IV. CONCLUSION

In addition to the above arguments, Applicant submits that each of the pending claims is patentable for one or more additional unique features. To this extent, Applicant does not acquiesce to the Office's interpretation of the claimed subject matter or the references used in rejecting the claimed subject matter. Additionally, Applicant does not acquiesce to the Office's combinations and modifications of the various references or the motives cited for such

combinations and modifications. These features and the appropriateness of the Office's combinations and modifications have not been separately addressed herein for brevity. However, Applicant reserves the right to present such arguments in a later response should one be necessary.

In light of the above, Applicant respectfully submits that all claims are in condition for allowance. Should the Examiner require anything further to place the application in better condition for allowance, the Examiner is invited to contact Applicant's undersigned representative at the number listed below.

Respectfully submitted,



Hunter E. Webb
Reg. No.: 54,593

Date: 06/19/2006
Hoffman, Warnick & D'Alessandro LLC
Three E-Comm Square
Albany, New York 12207
(518) 449-0044
(518) 449-0047 (fax)

RAD/hew